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Rutan & Tucker, LLP. Hani Z. Sayed 611 ANTON BLVD SUITE 1400 COSTA MESA, CA 92626			EXAMINER PALO, FRANCIS T	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/317,303  
Filing Date: May 24, 1999  
Appellant(s): DONOHO, BRUCE A.

**MAILED**

NOV 15 2007

**GROUP 3600**

Mr. Robert D. Fish

For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 8/15/2007 appealing from the Office action mailed 2/26/2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which, will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

GB 2344269A	RICHARDSON	7-2000
US 3,282,000	SHAW	11-1996
US 2,777,171	BURNSIDE	1-1957

Dictionary.com Unabridged (v 1.1); rail

FactMonster.com; cross: Cross Shapes

MR. JOSEPH WISBACHER;  
DECLARATION UNDER 37 USC 1.132; ON BEHALF OF APPLICANT;  
REGARDING APPLICANT'S PATENTABILITY ASSERTION OF THE PRODUCT-BY-  
PROCESS LIMITATION RECITED IN THE INDEPENDENT CLAIMS 10, 31 AND 35.

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 10-12, 16-18, 20 and 22-34** are rejected under 35 U.S.C. 103(a),  
as being unpatentable over **Richardson** (GB 2344269A) 1998,  
in view of **Shaw** (US 3,282,000) 1963.

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Regarding **independent claim-10**:

**"A bird deterrent for mounting on a surface, comprising:  
an elongated rail of plastic;"**

Richardson '269 teaches "a bird deterrent device comprising a base element of plastics material", in the first line of the Abstract, and the base element (15) of Richardson, as depicted in figure-1, is read as an elongated rail as claimed, as the term rail confers various horizontal considerations (wood or metal specifically), such as (broadly) a bar of material fixed horizontally for any of various purposes, such as for a support or barrier (Dictionary.com Unabridged (v 1.1)), and since applicant has not recited an elongated rail of wood or metal in the claim, but rather plastic, the examiner submits that the plastic base or rail of Richardson is equivalent to the broadly recited plastic base or rail of the instant invention.

**"a plurality of pairs of prongs extending laterally from opposite sides of the rail such that successive prongs on each side of the rail alternate between a higher position and a lower position;"**

As depicted in figure-1 of Richardson, plural repeating pairs of prongs (11-12) and (13-14) are evident, and Richardson teaches that the wider base or root of each of the prongs (11-14) is provided by a projection (of comparable width to the prong root) that extends laterally from the main path of the strip (15)" (col.-4, line-9 thereabout); this lateral teaching is read as 'prongs extending laterally', as broadly claimed, and this configuration of Richardson clearly distinguishes from prongs which could have extended upwards from the base strip (such as taught by Shaw '000 in the prior art),

rather than laterally and upwardly from the base as taught by Richardson and as extending laterally as broadly claimed.

Further, as is evident from figure-3 of Richardson, successive prongs (11) and (13) on each side of the rail (15) alternate between a higher position and a lower position as claimed.

**“a plurality of upwardly extending intermediate prongs disposed among the pairs of laterally extending prongs;”**

While Richardson does not depict plural intermediate prongs disposed among the pairs of laterally extending prongs as claimed, Richardson teaches in the first sentence of the Abstract “, a base element of plastics material molded integrally with a plurality of plastics material prongs extending at at least four different angles to the base element”, from which, the examiner takes the position that Richardson is contemplating additional prong(s), which serves as the motivation or teaching to modify Richardson with a fifth (or intermediate) prong as claimed.

**Shaw '000** is relied upon for the obviousness teaching of a plastic bird deterrent having upwardly extending intermediate prongs as claimed, such as depicted in figures 1, 4 and 7 (element-20).

It is submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have provided Richardson with an intermediate prong (20) such as taught by Shaw, as Richardson while depicting four prongs at four angles contemplates more than four angles to the base element as discussed above, and in order to effect more than four angles to the base, additional prongs would be required for that effect such as taught by the upwardly extending prongs (20) of Shaw in the '000 patent, and while Richardson contemplates more than four prongs the earlier patent to Shaw fairly well teaches the configuration as claimed.

In the alternative, and in view of the guidance provided by the Supreme Court in *KSR*, the examiner expects that a person of ordinary skill in the art would exercise ordinary creativity, common sense and logic, and that Richardson '269 in particular, as teaching more than four different angles to the base element would look to the prior art in arriving at more than four angles as contemplated in his disclosure, to try from a number of identified and predictable prong positions those positions in his device to yield predictable results of deterring birds via the utilization of plural prongs extending at various angles from the base; as, where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)).



Accordingly, Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396).

Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

**“and, wherein the rail, the pairs of laterally extending prongs and the intermediate prongs are all injection molded as a single continuous piece.**

“The recitation of “injection molded as a single continuous piece” is considered by the examiner to be a product-by-process limitation within an apparatus claim, and that the claimed bird deterrent appears to be the same or similar to the integrally molded plastic deterrent of Richardson as relied upon by the examiner in a showing of obviousness and as discussed by Richardson in the first line of the '269 patent,

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and that the product of the instant invention does not depend on the process of making it, contrary to the arguments by applicant that the instant invention does indeed depend on the process of making it as recited in the apparatus claims.

This contention by the applicant is supported by the Declaration of Mr. Josef Wisbacher who declares one of ordinary skill in the art would have thought that this is/was impossible to mold an elongated, molded plastic bird deterrent such as that claimed by the applicant in his application (paragraph-4), and that Mr. Wisbacher admits to having no particular knowledge or experience in patent law and does not feel comfortable drawing legal conclusions related to such law (paragraph-3), wherein Mr. Wisbacher then concludes with, if the applicant had brought his solution to him at the time the instant invention was filed, he "would have been extremely skeptical of his chances of success....not to mention the high cost of developing and producing a tool/mold to accomplish this" (paragraph-5).

The examiner respectfully submits that the perception of Mr. Wisbacher as to what applicant claims as his invention is apparently different from what the applicant is actually broadly claiming in his instant invention, and as such the opinion of Mr. Wisbacher cannot be relied upon as factual evidence that the product-by-process limitation imparts a distinctive structural characteristic to the claimed invention, as Mr. Wisbacher may be relying on drawings of the instant invention rather than what is claimed by the applicant.

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Furthermore, the concluding comment of Mr. Wisbacher of the "high cost of developing and producing a tool/mold to accomplish the process limitation" appears to contradict the declaration that "one of ordinary skill in the art would have thought that this is/was impossible to mold an elongated, molded plastic bird deterrent such as that claimed by the applicant in his application", especially in light of the Richardson teaching of an integrally molded plastic bird deterrent; for the preceding reasons, while the product-by-process limitation has been afforded consideration, it has been determined to not impart a distinctive structural characteristic to the claimed bird deterrent, and as such is not afforded patentable weight in the claim.

**Regarding claim-11:**

The discussion above regarding claim-10 is relied upon.

Richardson depicts in figure-3 the pairs of prongs (11,12) and (13,14) each having one prong extending from the rail at a higher angle and one prong that extends from the rail at a lower angle as claimed; that is, as depicted, with the pair of prongs (11) and (12), prong (11) is at a lower angle than corresponding prong (12), with the same depicted in prong pair (13,14).

**Regarding claim-12:**

The discussion above regarding claim-11 is relied upon.

Richardson as modified by Shaw is readable on the instant claim, as Richardson teaches angles less than the 90° intermediate prong.

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**Regarding claims 16 and 17:**

The discussion above regarding claim-10 is relied upon.

Richardson depicts a base readable as a rail and side projections extending from the base (rail) continuous with the rail, as claimed.

**Regarding claim-18:**

The discussion above regarding claim-10 is relied upon.

Richardson teaches prongs extending upwards from side projections extending laterally from the main path of the strip-like base element at line-15 (thereabout) on page-3, as claimed.

**Regarding claims 20 and 22:**

The discussion above regarding claim-10 is relied upon.

Prongs as claimed (round cross-section with a tip), are readily apparent from figure-1 of Richardson.

**Regarding claims 23 and 24:**

The discussion above regarding claim-10 is relied upon.

Richardson teaches (depicts) a base (read as a rail) having a flat bottom surface and a trough; the trough located on the upper surface of the base.

Note: it is not clear from the claim language which side the trough is located on.

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Regarding **claim-25**:

The discussion above regarding claim-10 is relied upon.

Richardson depicts in figure-1 lateral structure(s) readable on a ridge, as claimed.

Regarding **claim-26**:

The discussion above regarding claim-10 is relied upon.

Richardson depicts a tapered spike readable as having first and second portions having a round cross-section; it would be reasonable to assume that Richardson as modified by Shaw would retain the tapered prong shape.

Regarding **claim-27**:

The discussion above regarding claim-10 is relied upon.

Richardson as modified by Shaw renders a five-fanned projection as claimed, and Richardson teaches at least four different angles in the Abstract.

Regarding **claim-28**:

The discussion above regarding claim-10 is relied upon.

Richardson as modified by Shaw renders a normal extending prong as claimed; that is, 90° from the rail.

Regarding **claim-29**:

The discussion above regarding claim-10 is relied upon.

As discussed above in the rejection of claim-28, Richardson as modified by Shaw renders a normal extending prong as claimed, and while Richardson teaches ridges running along the upper surface of the rail (base), Richardson is silent as to upwardly extending prongs being normal to a ridge running along an upper surface of the rail.

Shaw teaches normal prong extension from a ridge as depicted in figures 4 and 7.

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have modified the deterrent of Richardson to include an upwardly extending intermediate prong as taught by Shaw and as claimed, as, where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)), as laid out above in the rejection of independent claim-10 above.

Accordingly, Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results;

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absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ2d at 1518-19 (BPAI, 2007) (citing *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396).

Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

Regarding **claim-30**:

The discussion above regarding claim-10 is relied upon.

Richardson teaches transverse grooves or channels (18) readable as cutting notches on the underside of the base (rail) as claimed (col.-5, line-34 thereabout).

Regarding **independent claim-31**:

The discussion above regarding independent claim-10 is relied upon as encompassing the broad instant claim; specifically, the obviousness of modifying the four prong integrally molded plastic bird deterrent of Richardson, effecting a five rayed deterrent as claimed, has sufficiently been addressed above in the rejection of claim-10.

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Regarding **claim-32**:

The discussion above regarding claim-31 is relied upon; further, the discussion above regarding the rejection of claim-11 is relied upon as encompassing the instant claim.

Regarding **claim-33**:

The discussion above regarding claim-31 is relied upon.

The alternating angle configuration as claimed, is readily apparent in the deterrent of Richardson as depicted in figure-3.

Regarding **claim-34**:

The discussion above regarding claim-31 is relied upon.

Richardson as already discussed in the rejection of claim-20, teaches a round cross-section, which is apparent from the figures. As claimed.

**Claims 13-15** are rejected under 35 U.S.C. 103(a),  
as being unpatentable over **Richardson** and **Shaw**,  
as applied to claims 10 and 11 above,  
and further in view of **Burnside** (US 2,777,171) 1951.



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Regarding **claims 13-15**:

The discussions above regarding claims 10 and 11 are relied upon.

Richardson teaches prong angles on the order of 60 and 82° to the underlying base (page-4, lines 25 and 36) and therefore on the order of 22° difference between the prongs ( $82-60=22$ ); Richardson does not teach about 30 and 70° and a difference of about 40°, as claimed.

Richardson in column-4 at lines 18 and 24 (thereabout) recites, "in this example the angles....."; the language is read as motivation for other angles to be utilized other than discussed and depicted in the teaching.

Burnside '171 teaches prongs (11-15) on a bird deterrent "bent upwards at different angles.", (column-3, lines 22-23) and prongs (21-25), "bent at somewhat different angles than those of figure-1", (column-3, lines 28-29), see figures 1 and 2.

The Examiner submits that Burnside teaches the angles claimed in the instant claims, or at least the obviousness for that capability, that is; prong angles of about 30 and 70° are apparent from the figures 1 and 2 of Burnside, particularly as regards prongs (22) and (24) as depicted in figure-2.

It would have been obvious therefore to one of ordinary skill in the art at the time the invention was made, to have modified the deterrent of Richardson to include the prong angles as claimed, and depicted and inferred by Burnside, for the known advantages of that feature; that is, in deterring birds.

In the alternative, and in view of the guidance provided by the Supreme Court in *KSR*, the examiner expects that a person of ordinary skill in the art would exercise ordinary creativity, common sense and logic, and that Richardson '269 in particular, as teaching more than four different angles to the base element would look to the prior art in arriving at more than four angles as contemplated in his disclosure, to try from a number of identified and predictable prong positions those positions in his device to yield predictable results of deterring birds via the utilization of plural prongs extending at various angles from the base; as, where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)).

Accordingly, Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396).

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Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

**Claim-21** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Richardson** and **Shaw** as applied to claim-10 above, and further in view of **Peles** (US 2,938,243) 1953.

Regarding **claim-21**:

The discussion above regarding claim-10 is relied upon.

Richardson teaches a conical shape prong having circular-shape in cross-section; Richardson is silent however as to a cross-shaped cross-section configuration as claimed.

The limitation cross-shape in cross-section does not serve to adequately convey applicant's prong cross-section as depicted in the technical disclosure because of the many interpretations of the shape recited.

**Peles '243** is relied upon for the obviousness of the broad limitation as the reference depicts prong shape features in common with the claimed prong shape. Specifically, Peles teaches a strengthening rib (21), which would be obvious to try on the prong of Richardson, as a means to provide rigidity such as taught by Peles, thus a predictable result, and such configuration could be readable on the claimed cross-section, as a "T" shape is a known cross-shape as broadly claimed. (FactMonster.com: cross: Cross Shapes)

Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have modified the deterrent of Richardson to include the prong cross-section as claimed and as taught by Peles, for the known advantage of that feature as taught by Peles, as where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)), as laid out above in the rejection of independent claim-10 above.

Accordingly, Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results;

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absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a).

Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

**Claim-35** is rejected under 35 U.S.C. 103(a),  
as being unpatentable over **Richardson** in view of **Burnside**.

Regarding **independent claim-35**:

Richardson as discussed above in the rejection of claim-10 teaches an integrally molded deterrent as claimed, and teaches prong angles on the order of 60 and 82° to the underlying base (page-4, lines 25 and 36); Richardson does not specifically recite no more than 70°, as claimed.

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Burnside as discussed above in the rejection of claims 13-15 provides the obviousness for various angles, which would encompass the claimed 70° prong angle.

It would have been obvious therefore to one of ordinary skill in the art at the time the invention was made, to have modified the deterrent of Richardson to include the prong angles as claimed, as, where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)), as laid out above in the rejection of independent claim-10 above.

Accordingly, Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

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Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art,

The claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

### **(10) Response to Argument**

#### **VII. ARGUMENT**

**A. Rejection of claims 10-12, 16-18, 20 and 22-34 under 35 U.S.C. § 103(a) as being unpatentable over Richardson (GB 2344269A) in view of Shaw (US 3,282,000).**

##### **1. The Office Failed To Establish A *Prima Facie* Showing Of Obviousness.**

**35 U.S.C. 103(a) requires that the patent office support its obviousness rejections with a *prima facie* showing. (*In re Royka*, 490 F.2d 981,180 USPQ 580 (CCPA 1974). That wasn't done in this case.**

**Independent claims 10, 31 and 35 all recite a bird deterrent device having: (1) an elongated rail; (2) pairs of laterally extending prongs at alternating heights; and (3) a plurality of upwardly extending intermediate prongs.**

**None of the references cited by the office teach or suggest including all three components in a single device.**

**Instead, the Office merely offered that the claimed combination would have been a good idea because it would have made a good product. That type of reasoning just isn't sufficient for a *prima facie* showing.**

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**In addition, there is no reason to believe that inclusion of intermediate prongs would have enhanced the deterrent function of Richardson devices. Robinson's devices already have prongs at 4 different angles, (60°, 72°, 108° and 120°), so it is unclear why a fifth set vertical prongs would make any difference.**

The examiner respectfully submits that sufficient evidence has been presented to support a *prima facie* case of obviousness, and that a person of ordinary skill in the art would have possessed the background knowledge and apparent reason to adapt the teachings presented in the previous office actions, and that it is not a requirement that each of the references relied upon in combination, individually recite all the limitations of the instant claim(s) as argued; however, this would not be the case if a 35 USC 102 rejection had been relied upon, as it is required that a reference relied upon in an anticipatory rejection teach each and every limitation of the claim(s) to be a proper rejection.

A review of the preceding office action fails to produce the "offering" language attributed to the examiner that, "the office merely offered that the claimed combination would have made a good product", as a reasoning for a *prima facie* showing. Rather, Richardson '269 as the primary reference, provides the motivation and suggestion to include a fifth or more prongs in the deterrent, and the teachings of Shaw '000, which predate the Richardson patent comfortably, is relied upon for the teaching of four or more prongs and an upwardly extending normal prong as claimed. Shaw '000 merely teaches thirty-four years prior to Richardson '269, that plastic bird deterrents having five rays (prongs), especially an upwardly extending intermediate prong as claimed,



were well-known in the art as a means to effect bird deterrent, and that it would have been obvious to incorporate a fifth prong as claimed in the deterrent of Richardson because Richardson contemplates the additional prong and Shaw teaches how and where an additional prong could be utilized. That Richardson's device has four prongs and it is unclear as to why a fifth vertical prong would make any difference, is not a convincing argument, as it has been argued that Richardson contemplates four or more prongs in the first line of his Abstract.

In the alternative the examiner submits that in view of the guidance provided by the Supreme Court in *KSR*, the examiner may respond that *KSR* forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness, and that while the examiner has provided some motivation or suggestion to combine the teaching of Shaw with Richardson, the examiner has additionally articulated a reason or motivation to further support an obviousness rejection under 35 USC 103 for applicant's consideration, based upon the expectation that a person of ordinary skill in the art would exercise ordinary creativity, common sense and logic, particularly as concerns the matter of determining the number and angular placement of a plurality of prongs for use in a bird deterrent.

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## **2. The Claimed Combination Is Antagonistic To Richardson's Goals.**

**The Office maintains that including the intermediate pieces along with the others would have been an obvious variant (a mere design choice).**

**That argument, however, fails because one of Richardson's goals is to make stackable devices. (See Richardson col. 2, lines 26-33).**

**"Advantageously the lateral staggering of the first and second pairs of prongs is such that, when viewed in the said direction, the two inner prongs (i.e. one from a first pair and one from a second pair) are angled to one another without mutually overlapping, i.e. without crossing over one another. This assists in nesting of one such bird deterrent device within another for storage and/or packing and/or transportation." (Italics added)**

**One of ordinary skill in the art would have immediately appreciated that use of intermediate prongs would be entirely incompatible with stacking, and would have rejected that combination.**

**Richardson also had the goal of producing prongs in alternating mirror image formation. (See Richardson col. 4, lines 27-31 .) Inclusion of vertical intermediate prongs would not be inconsistent with that goal, but one of ordinary skill in the art would not have considered vertical prongs where the goal was alternating mirror image prongs.**

That Richardson in contemplating more than four angles to the base element would preclude such a configuration because it would be inconsistent with the advantages attributed to the four-rayed configuration claimed by Richardson, such as stackability, is not convincing, because in contemplating more than four prongs, Richardson may not have been concerned with the stackability of the resulting five-rayed bird deterrent as is a capability of his four-rayed bird deterrent.

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### **3. Shaw Adds Nothing To Support The Office's Rejection Of The Claims**

**Shaw teaches a bird deterrent with an elongated base member and a plurality of sharp prongs.**

**The prongs are not part of a single continuously molded piece as recited in the rejected claims.**

**Instead the separately molded prongs are installed onto the base member via a plurality of rows of sockets.**

**"The elongated strip-type base support (4) has a plurality of rows of sockets (24) disposed therein. The sockets (24) as shown open onto the side walls (8) and (10), and also onto the top wall (12). The sockets are provided so as to releasably but tightly receive a plurality of projecting shaft elements (20)." (See Shaw col. 2, lines 50-56).**

**There is absolutely nothing in Shaw that teaches, suggests or motivates one of ordinary skill in the art to fabricate the prongs together with the base as a single continuous piece. In fact, just the opposite is true. Shaw teaches that the objective of his invention is "the provision of such a device which is so constructed that spikes or barbed elements thereof can be easily removed from protruding positions". (See Shaw col. 1, lines 61-63). Easy removal of the prongs is completely inconsistent with a unitary molded device.**

Applicant's arguments are not convincing because, Shaw is merely relied upon for the teaching of an upwardly extending intermediate prong in a five-rayed configuration, and merely teaches a consideration Richardson would consider in a contemplated five-rayed design, and Shaw is not relied upon for the teaching of the product-by-process limitation recited in the claim, as Richardson as the base reference teaches that claimed limitation.

#### **4. The Office Is Using Impermissible Hindsight To Select Elements**

##### **From Different References - Against The Knowledge At The Time**

The Office is also using impermissible hindsight to combine specific elements from completely different references, to produce a combination for which there is absolutely no teaching, suggestion, or motivation.

Richardson and Shaw each convey to one of ordinary skill that they have completely solved the problem at hand. One of ordinary skill in the art would not be motivated to combine the two solutions, each of which supposedly provides a complete solution to the problem.

Shaw does not teach one to build a device with prongs and base molded as a single continuous piece while Richardson does not teach one to build a device with upwardly pointing intermediate prongs. Only with the benefit of hindsight would one be motivated to combine ideas from Richardson and Shaw.

Even if one were to combine those two ideas, it was completely non-obvious as of the critical date to combine the references as suggested by the Office - because it was accepted in the art that such a combination was impossible.

The accepted knowledge at the time was that one could only manufacture a device such as that currently claimed by gluing together separately molded pieces. (See Wisbacher declaration).

It was not until the appellant disclosed alternating prongs (high lateral (24), upward (22), low lateral (26), upward (22); see figure 2, figure 3 and paragraph 2 of detailed description) that it became apparent that such a device could be molded at all. (See Wisbacher declaration).

The examiner has already sufficiently discussed that the primary teaching to Richardson provides the motivation and suggestion to construct a five-rayed deterrent, and that Shaw in teaching a five-rayed deterrent is merely relied upon for the obviousness of the placement of the fifth prong as claimed. Further, the examiner has rigorously attempted to convey to the applicant why his claimed product-by-process limitation in the device claims are not afforded patentable weight even in consideration of the *Declaration* made by Mr. Wisbacher earlier in the prosecution history.

Specifically, "The recitation of "injection molded as a single continuous piece" is considered by the examiner to be a product-by-process limitation within an apparatus claim, and that the claimed bird deterrent appears to be the same or similar to the integrally molded plastic deterrent of Richardson as relied upon by the examiner in a showing of obviousness and as discussed by Richardson in the first line of the '269 patent, and that the product of the instant invention does not depend on the process of making it, contrary to the arguments by applicant that the instant invention does indeed depend on the process of making it as recited in the apparatus claims.

This contention by the applicant is supported by the Declaration of Mr. Josef Wisbacher who declares one of ordinary skill in the art would have thought that this is/was impossible to mold an elongated, molded plastic bird deterrent such as that claimed by the applicant in his application (paragraph-4), and that Mr. Wisbacher admits to having no particular knowledge or experience in patent law and does not feel comfortable drawing legal conclusions related to such law (paragraph-3), wherein Mr. Wisbacher then concludes with, if the applicant had brought his solution to him at the time the instant invention was filed, he "would have been extremely skeptical of his chances of success....not to mention the high cost of developing and producing a tool/mold to accomplish this" (paragraph-5).

The examiner respectfully submits that the perception of Mr. Wisbacher as to what applicant claims as his invention is apparently different from what the applicant is actually broadly claiming in his instant invention,

and as such the opinion of Mr. Wisbacher cannot be relied upon as factual evidence that the product-by-process limitation imparts a distinctive structural characteristic to the claimed invention, as Mr. Wisbacher may be relying on drawings of the instant invention rather than what is claimed by the applicant.

Furthermore, the concluding comment of Mr. Wisbacher of the "high cost of developing and producing a tool/mold to accomplish the process limitation" appears to contradict the declaration that "one of ordinary skill in the art would have thought that this is/was impossible to mold an elongated, molded plastic bird deterrent such as that claimed by the applicant in his application", especially in light of the Richardson teaching of an integrally molded plastic bird deterrent; for the preceding reasons, while the product-by-process limitation has been afforded consideration, it has been determined to not impart a distinctive structural characteristic to the claimed bird deterrent, and as such is not afforded patentable weight in the claim.

#### **5. The Dependent Claims Are Allowable By Virtue Of Their Dependency**

**Claims 11-16-18, 20, 22-30 and 34 should all be in condition for allowance by virtue of their dependence on the allowable independent claims.**

**Furthermore, each of the claims 11-16-18, 20, 22-30 and 34 comprise additional novel elements and features that are not taught or suggested by Richardson and Shaw.**

The examiner has sufficiently presented his position regarding the applicant's presumed novelty of the independent claims in the response to applicant's arguments and in the rejections of the claims as presented in this Examiner's Answer.

Art Unit: 3644

As regards the patentability of the dependent claims 13-15 and 21, those arguments follow and are addressed below in response to said applicant's specific claim rejection rebuttals.

**B. Rejection Of Claims 13-15 Under 35 U.S.C. § 103(A) As Being Unpatentable Over Richardson And Shaw And Further In View Of Burnside (US 2,777,171).**

**Burnside shows a bird barrier with various cross members on a base member. The cross members and the base are all separate pieces. (See Burnside, col. 3, lines 34-47).**

**Burnside thus fails to teach that: (1) the rail; (2) the pairs of laterally extending prongs; and (3) the intermediate prongs are all injection molded as a single continuous piece.**

**In addition, Burnside fails to teach having laterally extending prongs extend laterally at the specifically claimed angles, (30 degrees and 70 degrees). Claims 13-15 are all allowable over the cited art.**

The examiner submits that Burnside is relied upon solely for the obviousness of utilization of prong angles to the base element as claimed, and further that a person of ordinary skill in the art would have exercised ordinary creativity, common sense and logic to arrive at any angular placement of a deterrent prong in a base element supporting said prong(s) as claimed; and further that a proper application of the TSM test was relied upon in the finding of obviousness as presented in the claim rejections.

Again, the process-by-product limitation has been sufficiently discussed above.

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**C. Rejection Of Claim 21 Under 35 U.S.C. § 103(A) As Being Unpatentable Over Richardson And Shaw And Further In View Of Peles (US 2,938,243)**

**This collection of references once again fails to teach the claimed combination.**

**Peles teaches a series of straight finger portions on a body portion, where the finger portions are of different heights and point straight into the air.**

**Peles fails to teach, suggest, or provide any motivation for first and second members of each of the plurality of pairs of laterally extending prongs include at least some portion having a cross-shaped cross-section as recited in claim 21. That claim is allowable over the cited art.**

Again, applicant has not sufficiently distinguished his bird deterrent structurally from the prior art teachings, especially in consideration of the teaching of Richardson. The claim-language "cross-shaped cross-section" as recited in the claim, is rather broad in meaning, as there are many interpretations of that shape. The examiner however has given consideration to the limitation by turning to the technical disclosure and drawings of applicant by presenting the teaching of Peles '243, in that the patent shares similar prong features as depicted in applicant's drawings, specifically, the teaching of a reinforcing rib (21) to provide rigidity to a pointed tip prong. The examiner maintains that a person of ordinary skill in the art would have exercised ordinary creativity, common sense and logic in evaluating various prong configurations suitable for a present day bird deterrent, and further, if the Board of Appeals reverses the examiner's rejection, applicant can expect a search of the related arts which teach spikes or prongs to arrive at a reason or rationale for a finding of the obviousness of a cross-shaped cross-section as now broadly claimed in dependent claim-21.



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**D. Rejection Of Claim 35 Under 35 U.S.C. § 103(A) As Being Unpatentable Over Richardson In View Of Burnside.**

**Here again, the Office failed to establish a showing of prima facie obviousness.**

**The Office incorrectly relies on the upwardly pointing prongs in Burnside in combination with Richardson to render the appellant's invention unpatentable.**

**Not only does Burnside fail to teach or suggest injection molding a device in a single continuous piece, it specially calls for the base member and the spike members to be separate pieces.**

**Claim 35 is allowable over the cited art.**

Again the examiner points out that the individual references used in combination do not have to recite each and every feature of the instant invention, as if that were the case, the applicant would be arguing an anticipation rejection instead of an obviousness rejection.

The examiner maintains that it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have modified the deterrent of Richardson to include the prong angles as claimed, as, where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)), as laid out above in the rejection of independent claim-10 above.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Francis T. Palo

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